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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,092	07/21/2000	Solomon S. Steiner	PDC 116	4836
7590	10/06/2005		EXAMINER	
PATREA L PABST PABST PATENT GROUP LLP 400 COLONY SQUARE, SUITE 1200 1201 PEACHTREE STREET ATLANTA, GA 30361			PATEL, MITAL B	
			ART UNIT	PAPER NUMBER
			3743	
DATE MAILED: 10/06/2005				

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Group 3700

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/621,092

Filing Date: July 21, 2000

Appellant(s): STEINER ET AL.

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Patrea L. Pabst  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/12/05 appealing from the Office action

mailed 4/8/04.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 30, 41, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Keritsis (US 4,991,605).
3. **As to claim 41**, Keritsis teaches a capsule **610** to contain drug for use in an inhaler **620** comprising at least one keying surface **613, 619, 623** on an outside surface of a distal end of the capsule that is adapted to orient the capsule within the inhaler or identifies the drug to be placed in the capsule and at least one hole **615,617** allowing air to pass in, through and out of the capsule.
4. **As to claim 30**, Keritsis teaches a capsule further including medicament selected from the group consisting of liquid, powder, and gaseous medicaments (**See Col. 7, lines 49-68, Col. 8, lines 1-33**).
5. **As to claim 43**, Keritsis teaches a capsule wherein the keying surface is adapted to orient the capsule within the inhaler (**See Col. 5, lines 51-60**).
6. **As to claim 44**, Keritsis teaches a capsule further comprising a keying surface identifying the drug to be placed in the capsule (**It should be noted that the keying**

**surface of Keritsis is able to identify the drug to be placed in the capsule in as much as Applicant's since Applicant has not recited what structural aspect of the keying surface allows for a drug to be identified furthermore in Col.7, lines 14-16 disclose that the configuration of the container, i.e., capsule may vary depending upon the type and physical dimensions of the smoking articles in which the container is placed which disclosure the Examiner considers to teach identifying the drug placed in the capsule).**

7. **As to claim 45,** Keritsis teaches a capsule comprising a keying surface on the outside of one end which is adapted to orient the capsule within the inhaler and a keying surface on the other end which identifies the drug to be placed in the capsule (**See Col. 5, lines 51-60 and Col.7, lines 14-16.**)

#### **(10) Response to Argument**

8. In response to Appellant's arguments that Keritsis does not disclose a capsule for delivery of a drug using an inhaler having at least one hole for directing air through the capsule and does not disclose a keying surface on an outside surface of a distal end of a capsule, the Examiner directs Appellant's attention to the rejection of claim 41 above, in which case, the Examiner has specifically referenced each corresponding claimed limitation to the elements disclosed in Keritsis.

9. In response to Appellant's arguments that element 610 alone of Keritsis cannot be characterized as a "capsule" because it is open at one end and closed at the other end, the Examiner directs Appellant's attention to the Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Ed. which defines capsule as "a shell usually of gelatin for packaging

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something (as a drug or vitamins); also : a usually medicinal or nutritional preparation for oral use consisting of the shell and its contents" and "a compact often sealed and detachable container or compartment." It should be noted that the definition of a capsule does not require the capsule to be closed on both ends as is suggested by Appellant. Additionally, the Examiner directs Appellant's attention to Col. 6, lines 7-8, which disclose that the open end of element 610 could be closed.

10. In response to Appellant's arguments that Keritsis does not teach a keying element located at the distal end of the capsule but rather element **613** of Keritsis runs along the full length of the capsule **610**, then it is the Examiner's position that if the keying element 613 of Keritsis runs along the full length of the capsule 610, the full length would include both the proximal and distal end, and as such, Keritsis in fact does teach a keying element located at the distal end of the capsule.

11. In response to Appellant's statement that the combination of elements 610 and 620 forms the complete capsule, it should be noted that a "complete capsule" is not recited. Furthermore, the Examiner has taken the position (See above noted rejection) that element 610 alone is the capsule not the combination of elements 610 and 620. Finally, the Examiner reiterates based on the dictionary definition that the capsule need not be closed at both ends as suggested by Appellant to be construed as a capsule. Additionally, the Examiner directs Appellant's attention to Col. 6, lines 7-8, which disclose that the open end of element 610 could be closed. Although the Examiner has pointed out additional keying elements 619 and 623, the Examiner reminds Appellant

that there is at least one keying element, i.e., 613, which is located on an outer surface of the capsule 610.

12. In response to Appellant's arguments that Keritsis does not disclose a keying surface that orients the capsule within an inhaler, again the Examiner directs Appellant's attention to the rejection above. The Examiner has pointed out in the rejection above that the Examiner regards element 620 to be the inhaler and as such elements 613 of the capsule 610 do in fact orient the capsule 610 within inhaler 620 (See Fig. 7, also Col. 6, lines 5-8 which discloses that 613 is configured to fit inside element 620). In response to Appellant's arguments that Keritsis requires a wrapper to keep smoking article and container connected to each other and oriented in the desired position, the Examiner directs Appellant's attention to Col. 2, lines 28-31, which disclose that the article and container **may be** wrapped by an overwrapper. Keritsis does not require or necessitate a wrapper to keep the article and container oriented as improperly inferred by the Appellant.

13. In response to Appellant's arguments regarding claim 44 in which case the Appellant argues that Keritsis does not disclose how or where one would place an identifier for the drug to be placed in a capsule, Appellant does not recite such a feature in the claim. Again, the Examiner refers Appellant to the rejection of claim 44 above regarding the matter of the keying surface identifying the drug to be placed in the capsule. As to claim 45, Appellant does not positively recite a medicament in claim 45.

14. In response to Appellant's arguments with respect to claim 30 and that Keritsis does not disclose a medicament in the capsule, Appellant's attention is directed to Col.

7, lines 49-68, Col. 8, lines 1-33 as noted above in the rejection. Furthermore, Appellant argues that based on the dictionary definition of a medicament as provided by the Appellant, the smoking articles as taught by Keritsis do not constitute as a medicament. However, Keritsis along with teaching conventional tobacco containing smoking articles also teaches uncombusted air, uncombusted aerosol, and tasteless gases all of which would constitute medicament.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

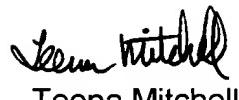
Respectfully submitted,



Mital Patel

Primary Examiner, Art Unit 3743

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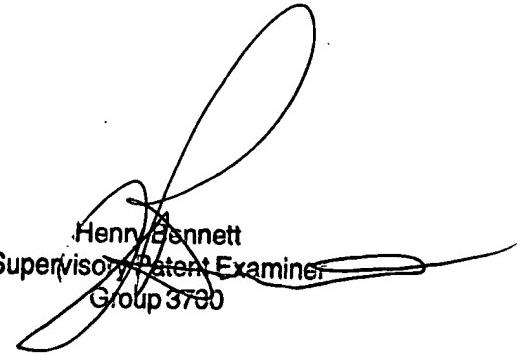


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